

REMARKS

Reconsideration of the present application as amended is requested.

Applicant notes that the Rule 131 Declarations of Lemoff and Jester were sufficient to antedate U.S. Patent No. 6,814,504 of Nakanishi et al. and the published application on which it is based.

In the third Office Action, all of the remaining claims were rejected for lack of novelty over U.S. Patent No. 6,560,395 of Shahid, newly cited by the examiner on a supplemental FORM PTO-892.

The examiner bears the burden of establishing a *prima facie* case of anticipation. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986). Each claim in issue must first be correctly interpreted to define the scope and meaning of each limitation. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). The prior art reference must disclose each element of the claimed invention, as correctly interpreted, and as "arranged in the claim." *Lindermann Maschinefabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

Independent Claim 1 has been amended to remove the ribbonizing web material limitation and to incorporate the limitations of Claim 15. Amended Claim 1 is directed to the embodiment of Fig. 2 and now requires first and second holders in the form of discrete body members (see elements 22 and 32 in Fig. 2) that maintain the first and second terminal portions of the optical fiber in different pitches. Shahid has a fiber ribbon 26, which is not a second discrete body member. Claims 3 and 8 - 9 have been canceled.

Independent Claim 11 has been amended to incorporate the limitation of Claim 16 that the first and second holders be provided by a common housing assembly, and Claim 16 has been canceled. Thus, amended Claim 11 is broadly directed to the embodiment of Fig. 3, but without all of the limitations of independent Claim 21. Shahid has no common housing assembly but instead uses ribbon cable 26 and a separate holder 30 made of composite bonding material 44

including tape 46 and adhesive 48 (See Fig. 3 of Shahid). Claims 12 - 15 and 17 - 19 have also been canceled.

Previously presented independent Claim 21 is directed to details of the embodiment of Fig. 3. More specifically, Claim 21 requires common housing assembly surrounding the first and second segments of the optical fibers except for the first and second terminal portions. Claim 21 further requires a plurality of alignment pins that extend from at least one end of the housing assembly. Claim 21 further requires a plurality of optical subassemblies (OSAs) arranged in an array, each OSA being optically coupled to a corresponding one of the second terminal portions of the second segments. Shahid has no common housing assembly and no alignment pins.


Previously presented independent Claim 22 is directed to details of the embodiment of Fig. 4. Claim 22 is similar to Claim 21, except that instead of the OSAs, the former requires a plurality of ferrules, each secured around a corresponding one of the second terminal portions of the second segments. The ends of the fibers 36 of Shahid that are received in receptacles 40 in optical device 24 have no ferrules.

On page three of the third Office Action, the examiner stated “[a] common injection-molded housing, alignment pins and ferrules around the second terminal portion [sic] are inherent.” To establish inherency, the extrinsic evidence (Shahid) must make it clear that the missing descriptive matter is necessarily present in the thing being described and that it would be so recognized by persons of ordinary skill in the art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The fact that a prior art reference is capable of being modified and the modification would anticipate the claimed invention is not legally sufficient to support anticipation based on inherency. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). Shahid has no common housing, but separate fiber holding means. Shahid has no alignment pins. Shahid has no ferrules.

For the foregoing reasons, withdrawal of the anticipation rejections of Claims 1, 11, 21 and 22 is requested. Alternatively, entry of the foregoing amendments is requested under Rule 116 subparagraphs (a)(1) and (a)(2) because it cancels claims and presents the remaining rejected claims in better form for consideration on appeal.

No additional fee is due at this time.

Respectfully submitted,

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